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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/919,768
Filing Date: July 31, 2001
Appellant(s): GRAINGER ET AL.

JAN 11 2008

GROUP 3600

Chad E. King
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 22, 2007 appealing from the Office action mailed January 24, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application Number 09/872,764

Application Number 09/919,864

Application Number 09/006,338 (see attached Board decision)

Application Number 09/996,341

(3) Status of Claims

The statement of the status of claims contained in the brief is substantially correct.

The Examiner ***withdraws*** the rejection of claims 1-12 and 14-22 under 35 USC 112, 2nd paragraph.

The Examiner ***withdraws*** the rejection of claim 21 under 35 USC 112, 1st paragraph.

The Examiner ***withdraws*** the rejection of claim 22 under 35 USC 101.

(4) Status of Amendments After Final

The amendment after final rejection filed on October 19, 2007 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is substantially correct.

In the summary of the claimed subject matter, the applicant states the following:

According to the method of claim 1, a second display section displays an identifier corresponding to the first reference. *Id.*, p. 3, ll. 13-17, p. 35, ll. 22-30, Fig. 20. The method also comprises providing ***an interface element (which is sometimes referred to in the Application as an "input select element," which can include, for example, a checkbox, electronic button, and/or the like)*** associated with the identifier; in an aspect, the interface element is configured to receive, from the user, input pertaining to the first reference. *Id.*, p. 3, ll. 15-10, p.35, ll. 1-8, Fig. 20. The input comprises information about a relationship between at least some of the citation information in the citation document and the first reference. *Id.* ***Fig. 20 illustrates, as one example of interface elements, a set of radio buttons 2022 and 2033.***

Page 3, lines 13-17 refer to "input select elements". Page 35, lines 22-33 refers only to "input select elements". There is no definition of "interface element" in the specification. Figure 20 does not show reference numbers 2022 or 2033 nor are they mentioned in the specification.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

Appellant notes that claims 21 and 22 have not been addressed in the rejections. Claims 21 and 22 are drawn to a system and program for performing the steps of the method set forth in claim 1. Any structure set forth in claim 21 (a server system with a processor) has been addressed in claim 1. Therefore, claims 1-12, 14, 16-19 and 21-22 are rejected under 35 U.S.C. Section 102(e) as being anticipated by

Porcari. The Examiner notes that appellant has not directly addressed the patentability of claims 21-22 (see footnote 2, page 13 of appellant's appeal brief).

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

The rejection of claims 1-12 and 14-22 under 35 USC 112, 2nd paragraph is ***withdrawn***.

The rejection of claim 21 under 35 USC 112, 1st paragraph is ***withdrawn***.

The rejection of claim 22 under 35 USC 101 is ***withdrawn***.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2001/0037460	PORCARI	11-2001
2003/0046307	RIVETTE et al.	3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 14, 16-19 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Porcari (US 2001/0037460).

Referring to Claims 1 and 21-22:

Porcari discloses a computer implemented method/system for performing the method, program with instructions for performing the method of processing documents received on a server system comprising:

storing a plurality of first electronic documents on the server system, the plurality of first electronic documents containing reference information to be disclosed to a patent office [0058];

receiving a second electronic document on the server system, the second electronic document including citation information for one or more prior art reference documents [0056];

displaying the citation information in the second electronic document to a user of a client system in a first display section [0056-0058]; and

displaying a plurality of identifiers and one or more input select elements in a second display section, each of the plurality identifiers corresponding to one of the plurality of first electronic documents [0058],

wherein the user enters information into the server system using the input select elements, the information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers [0056-0058].

Referring to Claim 2

Porcari discloses wherein the displayed citation information includes one or more references submitted to a patent office and an indication of whether or not each reference was considered by the patent office, and the information entered by the user indicates whether or not each of the plurality of identifiers corresponding to the first electronic documents were considered by the patent office [0056-0058].

Referring to Claim 3:

Porcari discloses wherein displaying the citation information includes displaying an image file of a form received from a patent office [0056].

Referring to Claims 4-5:

Porcari discloses wherein the form is a notice of references cited [0056].

Referring to Claim 6:

Porcari disclose wherein displaying a plurality of identifiers comprises displaying a plurality of patent numbers associated with a case [0056-0058].

Referring to Claim 7:

Porcari discloses wherein identifiers are United States Patent numbers [0058].

Referring to Claim 8.

Porcari discloses wherein identifiers are foreign patent numbers [0058].

Referring to Claim 9:

Porcari disclose wherein identifiers are serial numbers of patent publications.

Referring to Claim 10:

Porcari discloses wherein displaying a plurality of identifiers comprises displaying a plurality of publication titles [0058].

Referring to Claim 11:

Porcari disclose wherein the identifiers are links to the electronic documents [0056-0058].

Referring to Claim 14:

Porcari discloses wherein the displayed citation information includes one or more references.

Referring to Claim 16:

Porcari discloses wherein an electronic document is received by electronic mail [0029] [0033].

Referring to Claim 17:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a United States Patent [0056-0058].

Referring to Claim 18:

Porcari discloses herein at least one of the plurality of first electronic documents on the server system is an electronic version of a foreign patent document [0056].

Referring to Claim 19:

Porcari discloses wherein at least one of the plurality of first electronic documents on the server system is an electronic version of a publication [0058].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari.

Referring to Claim 12:

Porcari discloses an approval log which indicates that approval has been obtained from each co-inventor as to a document (Figure 3 (126) and [0015] [0033]).

Porcari does not disclose wherein the input select elements include a yes check box and a no check box pair for each of the plurality of identifiers, and wherein when the yes check box is mouse clicked by the user, the information indicates that the identifier corresponding to the yes check box has been considered by a patent office, and when the no check box is mouse clicked by the user, the information indicates that the identifier corresponding to the no check box has not been considered by the patent office.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a check box for approving whether a document has been reviewed or considered as a means for docket management.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porcari as applied to claim 14 above, and further in view of Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claim 15:

Porcari discloses the method set forth in claim 14.

Porcari does not disclose wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source.

However, Rivette discloses wherein the input select element is an electronic add button, and in accordance with mouse clicking the electronic add button, the information is entered by loading an electronic document from an external source [0292] [0396] [1192-1193].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the information disclosure statement method of Porcari the ability to add a document as disclosed in Rivette so as to be able to automatically and simultaneously correlate multiple patents.

(10) Response to Argument

A. Claims 1-12 and 14-22 are patentable under the second paragraph of 35 U.S.C. Section 112.

This rejection has been *withdrawn*.

B. Claim 21 is patentable under the first paragraph of 35 U.S.C. Section 112.

This rejection has been *withdrawn*.

C. Claim 22 is patentable under 35 U.S.C. Section 101.

This rejection has been *withdrawn*.

D. Claims 1-12, 14, and 16-19 are patentable under 35 U.S.C. Section 102(e) over Porcari.

Appellant states that Porcari fails to teach or suggest the method of managing prior art references recited by claim 1 and therefore cannot anticipate either claim 1 or any of the claims that depend therefrom.

Claim 1 is directed to:

A computer implemented method of processing documents received on a server system comprising:

storing a plurality of references on the server system, wherein the plurality of references are electronic documents, the plurality of references comprising a first reference comprising a set of reference information to be disclosed to a patent office;

receiving a citation document on the server system, wherein the citation document is an electronic document including citation information for one or more prior art reference documents;

providing communication between the server system and a client system, wherein the client system is configured to provide interaction between a user and the server system;

displaying the citation information in the citation document to a user of a client system, in a first display section; and

displaying, in a second display section, an identifier corresponding to the first reference; and

providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

First, the Examiner notes the following as to the interpretation of the claim limitations in claim 1:

Claim 1 is directed to a computer implemented **method of processing documents received on a server system** comprising:

storing a plurality of references **on the server system**, wherein the plurality of references are **electronic documents**, the plurality of references comprising a first reference comprising a set of reference **information** to be disclosed to a patent office (The Examiner asserts that this limitation can be interpreted as **storing a plurality of electronic documents on the server system, the plurality of documents comprising a document comprising a set of information**. The Examiner asserts

that the fact that the information is to be disclosed to a patent office is the intended use of the data and would be considered non-functional descriptive data);

receiving a citation document on the server system, wherein the citation document is an electronic document including citation information for one or more prior art reference documents (The Examiner asserts that this limitation can be interpreted as ***receiving a document on the server system, wherein the document is an electronic document including information for one or more documents***);

providing communication between the server system and a client system, wherein the client system is configured to provide interaction between a user and the server system;

displaying the citation information in the citation document to a user of a client system, in a first display section (The Examiner asserts that this limitation can be interpreted as ***displaying information in the document to a user of a client system in a first display section***); and

displaying, in a second display section, an identifier corresponding to the first reference (The Examiner asserts that this limitation can be interpreted as ***displaying, in a second display section, an identifier corresponding to a document***); and

providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, ***the input comprising information about a relationship between at least some of the citation information in the citation document and the first***

reference (The Examiner asserts that this limitation can be interpreted to as ***providing an interface element configured to receive, from the user input pertaining to a document, the input comprising information***. The Examiner asserts that the fact that the element is ***associated*** with the identifier simply means that the element is related to the identifier in some way or manner. The Examiner further asserts that input ***pertaining*** to the first reference or document can be any type of information that relates to or is relevant to the first document. The fact that the input comprises information "about a relationship between the information" can be any type of information regarding a relationship. It can be information stating that the documents are written by the same author/inventor/attorney, information stating that the documents are published by the same company, or related to the same subject matter, etc. The Examiner further asserts that the limitation of "providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input" is not a positive recitation of any input being actually received).

Moreover, the Examiner asserts that the fact that electronic documents are ***references***, that a document is a ***citation*** document, that the information is ***citation*** or ***reference*** information, that the ***reference*** information is ***information to be disclosed to a patent office***, that the input comprises information ***about a relationship between some of the citation information and the citation document and the first reference*** is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO)

must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191,209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate.

The Examiner asserts that the data identifying the documents as **reference** or **citation** documents, that the information is **citation** or **reference** information, that the **reference** information is **information to be disclosed to a patent office**, that the input comprises information **about a relationship between some of the citation information and the citation document and the first reference** adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with

the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, this data does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Furthermore, the Examiner asserts that Porcari discloses:

***a computer implemented method/system for performing the method,
program with instructions for performing the method of processing documents
received on a server system [0015] [0025]***

[0025] Referring now to FIG. 1, an on-line invention disclosure system 10 is illustrated. On-line disclosure system 10 is a web-based system having a web server 12 that is coupled to a plurality of users, one of which is shown as user computer 14. The web server 12 as will be further described below may be coupled to a directory server 16 containing user information and to a database system 18. Database 18 may contain both docketing information and disclosure information.

comprising:

***storing a plurality of electronic documents on the server system, the
plurality of electronic documents containing reference information to be
disclosed to a patent office ([0033] comment on prior art [0045] and [0058]***

[0045] Referring now to FIG. 4, step 109 is illustrated in further detail. In step 109, an optional search function may be included with the on-line invention disclosure system. The search is provided to give evaluators the state of the art to assist in their evaluation. A search inquiry is formulated in step 200. The search inquiry may be manually entered or search terms may be derived from the disclosure itself. Boolean searching may be performed. Preferably, natural language searching may be performed from using selected

sections of the invention disclosure that may include a detailed description section or the problem/solution section. Also, the user may be prompted to enter search terms to be used in addition to the disclosure information. Various types of natural searching language engines may be used. Typically, these natural language search engines rank the various terms of the search inquiries such as the portions of the invention disclosure and perform a search through various on-line search engines from various search vendors through a natural language search as shown in step 202. On-line search engines 204 provide the results of the search to the user. This preferably is a required step although the on-line disclosure system may make this step optional. The on-line search engine may include, for example, interfacing with the patent office website, or various other commercial searching websites known to those skilled in the art. Many corporations subscribe to a commercial search service vendor. In step 204, the results of the search are provided to the inventor. The results may, for example, provide the top ten results from the search. In step 208, the inventor may be prompted to provide a narrower search. In step 208 the search may be refined using the various terms received from the documents of the first search or previous searches and the search terms from the disclosure document. For example, various documents can be selected as being on point and the wording from these documents may be weighted in addition to the prior search in step 210. Other documents that are not relevant may receive a negative weighting so that similar documents do not appear on the **list of most relevant documents. The invention disclosure information** may then be repeatedly searched again in step 212 in view of the revised terms. Referring back to step 208, **after the search has been sufficiently refined, the results are stored together with the disclosure in step 214.**

The examiner asserts that storing a list of most relevant documents from a search and identified as invention disclosure information is storing a plurality of references on the server system wherein the documents comprise information to be disclosed to a patent office.

receiving an electronic document on the server system, the electronic document including citation information for one or more prior art reference documents [0045][0056];

[0045] Referring now to FIG. 4, step 109 is illustrated in further detail. In step 109, an optional search function may be included with the on-line

invention disclosure system. ***The search is provided to give evaluators the state of the art to assist in their evaluation.*** A search inquiry is formulated in step 200. The search inquiry may be manually entered or search terms may be derived from the disclosure itself. Boolean searching may be performed. Preferably, natural language searching may be performed from using selected sections of the invention disclosure that may include a detailed description section or the problem/solution section. Also, the user may be prompted to enter search terms to be used in addition to the disclosure information. Various types of natural searching language engines may be used. Typically, these natural language search engines rank the various terms of the search inquiries such as the portions of the invention disclosure and perform a search through various on-line search engines from various search vendors through a natural language search as shown in step 202. On-line search engines 204 ***provide the results of the search to the user.*** This preferably is a required step although the on-line disclosure system may make this step optional. The on-line search engine may include, for example, interfacing with the patent office website, or various other commercial searching websites known to those skilled in the art. Many corporations subscribe to a commercial search service vendor. In step 204, the results of the search are provided to the inventor. ***The results may, for example, provide the top ten results from the search.*** In step 208, the inventor may be prompted to provide a narrower search. In step 208 ***the search may be refined using the various terms received from the documents of the first search or previous searches and the search terms from the disclosure document.*** For example, various documents can be selected as being on point and the wording from these documents may be weighted in addition to the prior search in step 210. Other documents that are not relevant may receive a negative weighting so that similar documents do not appear on the ***list of most relevant documents.*** The invention disclosure information may then be repeatedly searched again in step 212 in view of the revised terms. Referring back to step 208, ***after the search has been sufficiently refined, the results are stored together with the disclosure in step 214.***

The Examiner asserts that a citation document and citation information is any prior art reference and any information provided in a prior art reference.

Moreover, Porcari further discloses:

[0055] The present invention proposes a system where the USPTO sends a **notification via email to the user notifying the user that an office action has**

been issued by the USPTO. The user either manually or automatically logs into the USPTO's server to retrieve the action. The retrieval may utilize the same PKI certificates used to transmit applications. The office actions should preferably be in the form of XML files so that relevant metadata such as serial numbers, due dates, examiner, group art unit and telephone information may be easily parsed and recorded into the docketing system. *The docketing system then notifies the attorney or docketing clerk via an email that a new action has been received. The notice contains a hyperlink to the action as well as due dates for response.*

[0056] *The system optionally includes a system to reference prior art documents and a method hyperlinks to the stored reference.* The USPTO requires disclosure of relevant references kno (sic) current rules require that paper copies of these references be provided with the patent appl (sic) appellant must later forward these paper copies. **The present invention anticipates a method Information Disclosure Statement in XML form that contains hyperlinks to identified docume (sic) the USPTO Patent Full Text and Image Database or the European Patent Office (EPO) esp@ce and the EPO maintain databases using Uniform Resource Locator (URL)-based systems wher U.S. Pat. No. 5,579,858 may currently be view through the hyperlink:"http://164.195.100 Sect1=PTO1&Sect2=HITOFF&d=PALL&p=1&u=/netah-tml/srchnum.htm&r=1&f=G&l=50&s1**

[0057] In those instances where there is no internet accessible archive, the present invention contemplates commercial prior art services that will host the document for permanent record storage. Access to the public and patent offices would be through a web interface or URL link as described. One example of a commercial internet-based prior art archive is IP.COM whose web page 15 www.ip.com. Linking the prior art eliminates the need to submit paper copies. Only one copy of the reference is needed for use with many applications.

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

Thus, the Examiner asserts that Porcari discloses receiving electronic documents on the server system with citation information for prior art references. ***providing communication between the server system and client system, wherein the client system is configured to provide interaction between a user and the server system*** [0025]

[0025] Referring now to FIG. 1, an on-line invention disclosure system 10 is illustrated. **On-line disclosure system 10 is a web-based system having a web server 12 that is coupled to a plurality of users**, one of which is shown as user computer 14. The web server 12 as will be further described below may be coupled to a directory server 16 containing user information and to a database system 18. Database 18 may contain both docketing information and disclosure information.

(abstract) A web-based document approval system that enables users to create, review and approve documents and ***to communicate these documents to other parties***. The system includes an approval function where the document being approved is stored to a central storage area. The central storage area cannot be modified or deleted by the users. Users are invited to review and approve the document and are provided a convenient hyperlink to the specific document. The system records the date and time that each user approved the document. A central storage area interfaces with a database. The database retrieves approver and approval information and prepares an approval log. The approval log may be in the form of an XML document that easily updates other database systems.

displaying the citation information in the electronic document to a user of a client system in a first display section ([0045] provide the results of the search to the user [0056-0058];

0056] The system optionally includes a system to reference prior art documents and a method hyperlinks to the stored reference. The USPTO requires disclosure of relevant references kno (sic) current rules require that paper copies of these references be provided with the patent appl (sic) appellant must later forward these paper copies. **The present invention anticipates a method Information Disclosure Statement in XML form that contains hyperlinks to identified docume** (sic) the USPTO Patent Full Text and Image Database or the

European Patent Office (EPO) esp@ce and the EPO maintain databases using Uniform Resource Locator (URL)-based systems where U.S. Pat. No. 5,579,858 may currently be viewed through the hyperlink: "http://164.195.100Sect1=PTO1&Sect2=HITOFF&d=PALL&p=1&u=/netah-tml/srchnum.htm&r=1&f=G&l=50&s1

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

and

displaying an identifier corresponding the electronic documents [0015]

[0033] [0046] [0058];

[0015] The invention enables users to collaborate, create, review and approve documents and to communicate these documents to other parties. In one aspect of the invention an on-line invention disclosure system includes a user computer and a web server having an identification subsystem. A database is coupled to the server. **The server provides user screens to the user to prompt users to provide user information to the server. The server receives disclosure information from the users and stores information in the database** and prompts the users to provide a password. Upon the proper password, access to the disclosure is granted. Users of the system may work collaboratively to create invention disclosures, patentability searches, patent applications, trademark applications and other types of documents. The system includes an approval function where the document being approved is stored to a central storage area. The central storage area cannot be modified or deleted by the users. Users are invited to review and approve the document and are provided a convenient hyperlink to the specific document. The system records the date and time that each user approved the document as well as the approving text.

[0029] SMTP 18 provides the formatting for the company specific email system. Various types of email formatting would be evident to those skilled in the art. WSL 30 provides **an identification subsystem whereby identification information such as the user's corporate ID and password are authenticated. A password may be established for each disclosure during**

the initial entry into the system. Thereafter, the password may be used to view the disclosure and view the status thereof. SAFile-up 32 is a software package provided by software artisans that allows the user's PC to couple various documents to the invention disclosure. LDAP 24 is coupled to directory server 16.

[0033] Referring now to FIG. 2, a block diagram of the process of the present invention is illustrated. As is described below, a user may be an inventor or just an author that enters the information in to the disclosure system 10. User and inventor are used interchangeably because in most circumstances the user is an inventor but need not be. The author system allows company personnel to enter inventions by non-company personnel in the system. In block 50, the disclosure is prepared on-line. Passwords or other security measures may be employed through the identification subsystem before access to the system may be gained. Preferably, a corporate directory service or other directory information may be used to assist the user in filling out the disclosure. ***For example, a get employee information block 52 may be coupled to the prepare disclosure on line block 50 to provide the user information at the user's request in response to some identification information such as an email ID, an employee number or the like. This employee user information thus becomes associated with the particular disclosure being prepared.*** Block 50 may also allow the user to identify other co-inventors and request approval from co-inventors in block 54. The co-inventors of block 54 are preferably notified via an email that the author has prepared an invention disclosure listing them as a co-inventor and that they should either assist in drafting the disclosure or approve the final draft. For convenience, the email notification may include a hyperlink so that the disclosure and a connection with the server may be obtained. In block 50, the inventor may be asked to fill in predetermined disclosure information such as a brief description or comments, comment on prior art, give a brief description on the new technology provided by the invention, various invention dates, provide classification information such as company classification codes, and miscellaneous other invention information such as whether a government contract was used or if the invention was disclosed to non-company personnel. ***The prepare disclosure on-line block 50 may also inquire whether other documents exist so that they may be attached to the disclosure as file attachments. The file attachments may be word processing documents, CAD files, presentation documents or various other types of documents.***

[0046] Referring now to FIG. 5, ***the invention disclosure system may also be coupled to an on-line docket system. Various information may be shared between the docket system and the on-line invention disclosure system.***

For example, common information such as a date stamp may be provided as well as other information not limited to the title, the classification code, inventor name, an inventor acknowledgement and an assignment. This information may be provided to the docketing system in step 300.

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. **The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document.** The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

Thus, since the claim language is given the broadest reasonable interpretation, a hyperlink can be a displayed identifier.

providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user input pertaining to the reference, the input comprising information about the relationship between at least some of the citation information in the second document and the first document.

[0015] The invention enables users to collaborate, create, review and approve documents and to communicate these documents to other parties. In one aspect of the invention an on-line invention disclosure system includes a user computer and a web server having an identification subsystem. A database is coupled to the server. ***The server provides user screens to the user to prompt users to provide user information to the server. The server receives disclosure information from the users and stores information in the database*** and prompts the users to provide a password. Upon the proper password, access to the disclosure is granted. Users of the system may work collaboratively to create invention disclosures, patentability searches, patent applications, trademark applications and other types of documents. The system includes an approval function where the document being approved is stored to a central storage area. The central storage area cannot be modified or deleted by the users. Users are invited to review and approve the document and are provided a convenient hyperlink to the specific document. The system records

the date and time that each user approved the document as well as the approving text.

[0033] Referring now to FIG. 2, a block diagram of the process of the present invention is illustrated. As is described below, a user may be an inventor or just an author that enters the information in to the disclosure system 10. User and inventor are used interchangeably because in most circumstances the user is an inventor but need not be. The author system allows company personnel to enter inventions by non-company personnel in the system. In block 50, the disclosure is prepared on-line. Passwords or other security measures may be employed through the identification subsystem before access to the system may be gained. Preferably, a corporate directory service or other directory information may be used to assist the user in filling out the disclosure. ***For example, a get employee information block 52 may be coupled to the prepare disclosure on line block 50 to provide the user information at the user's request in response to some identification information such as an email ID, an employee number or the like. This employee user information thus becomes associated with the particular disclosure being prepared.*** Block 50 may also allow the user to identify other co-inventors and request approval from co-inventors in block 54. The co-inventors of block 54 are preferably notified via an email that the author has prepared an invention disclosure listing them as a co-inventor and that they should either assist in drafting the disclosure or approve the final draft. For convenience, the email notification may include a hyperlink so that the disclosure and a connection with the server may be obtained. In block 50, ***the inventor may be asked to fill in predetermined disclosure information such as a brief description or comments, comment on prior art***, give a brief description on the new technology provided by the invention, various invention dates, provide classification information such as company classification codes, and miscellaneous other invention information such as whether a government contract was used or if the invention was disclosed to non-company personnel. The prepare disclosure on-line block 50 may also inquire whether other documents exist so that they may be attached to the disclosure as file attachments. The file attachments may be word processing documents, CAD files, presentation documents or various other types of documents.

[0039] Referring now to FIG. 3, the invention disclosure is prepared on-line in step 100. ***An author or inventor may prepare the invention disclosure.*** Preferably, the author or inventor or both obtain access through a corporate Intranet or the Internet. In step 102, ***the user enters identification***

information (ID) for the system. This may also consist of a password or other security if this is a subsequent access to the system. The following, however, is based upon an initial submission of an invention disclosure. In step 104, the information may be received from a central database or directory server maintained by the company. **Various invention data is filled into the disclosure in step 106. As described above, the invention data is preferably as detailed information as the inventor may provide. The invention data may be prompted from the on-line disclosure system through a series of direct questions and answers, or the user may be directed to various segments where broad questions are answered and the inventor may expound, or a combination of both. In step 107, if any documents such as prints, flow charts, CAD files or other information would be helpful to the preparation of a patent application from the disclosure, the documents may be attached so that they are stored in the system with the disclosure.**

[0045] Referring now to FIG. 4, step 109 is illustrated in further detail. In step 109, an optional search function may be included with the on-line invention disclosure system. **The search is provided to give evaluators the state of the art to assist in their evaluation.** A search inquiry is formulated in step 200. The search inquiry may be manually entered or search terms may be derived from the disclosure itself. Boolean searching may be performed. Preferably, natural language searching may be performed from using selected sections of the invention disclosure that may include a detailed description section or the problem/solution section. Also, the user may be prompted to enter search terms to be used in addition to the disclosure information. Various types of natural searching language engines may be used. Typically, these natural language search engines rank the various terms of the search inquiries such as the portions of the invention disclosure and perform a search through various on-line search engines from various search vendors through a natural language search as shown in step 202. On-line search engines **204 provide the results of the search to the user.** This preferably is a required step although the on-line disclosure system may make this step optional. The on-line search engine may include, for example, interfacing with the patent office website, or various other commercial searching websites known to those skilled in the art. Many corporations subscribe to a commercial search service vendor. In step 204, the results of the search are provided to the inventor. **The results may, for example, provide the top ten results from the search.** In step 208, the inventor may be prompted to provide a narrower search. In step 208 **the search may be refined using the various terms received from the documents of the first search or previous searches and the search terms from the disclosure document.** For example, various documents can be selected as being on point and the wording from these documents may be

weighted in addition to the prior search in step 210. Other documents that are not relevant may receive a negative weighting so that similar documents do not appear on the ***list of most relevant documents***. The invention disclosure information may then be repeatedly searched again in step 212 in view of the revised terms. Referring back to step 208, ***after the search has been sufficiently refined, the results are stored together with the disclosure in step 214.***

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. **The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.**

Thus, the Examiner asserts that Porcari discloses providing an interface element (see Figure 1 (14)) associated with an identifier (which can be the user identification information), wherein the interface element is configured to receive input from a user, wherein the input pertains to a reference and comprises information about the relationship between the citation information and the reference.

The appellant states, on page 14 of the Appeal Brief, that:

To the extent that Porcari discusses the management of prior art references, it does so in the context of preparing an information disclosure statement. Porcari does not address techniques for managing the information disclosure process, as recited by claim 1, which can, as noted above, help ensure that disclosure obligations are followed consistently. As noted above, one inventive feature of claim 1 is that it allows a user to view both a citation document (such as a PTO form 1449, to name an example), and identifiers of one or more references, ***in separate display sections on a display***. This feature allows the user to ensure that disclosure obligations are adhered to, and that the patent office's records are consistent with the user's records. Porcari does not even approach disclosing such a feature, and it therefore is unsurprising that Porcari fails to teach or suggest multiple elements recited by claim 1.

The Examiner asserts that claim limitations must be given their broadest reasonable interpretation in light of the specification without reading limitations from the specification into the claims. Appellant admits that Porcari discusses the management of prior art references in the context of preparing an information disclosure statement. Appellant then states that Porcari does not address techniques for managing the information disclosure process as recited in claim 1. Appellant further states that one inventive feature of claim 1 is that it allows a user to view both a citation document (such as a PTO form 1449) and identifiers of one or more references in separate display sections ***on a display***.

As stated above, the Examiner interprets the appellant's claim 1 as being directed to a computer implemented ***method of processing documents received on a server system*** comprising:

storing a plurality of electronic documents on the server system, the plurality of documents comprising a first document comprising a set of information

receiving a document on the server system, wherein the document is an electronic document including information for one or more documents;

providing communication between the server system and a client system, wherein the client system is configured to provide interaction between a user and the server system;

displaying information in the document to a user of a client system in a first display section; and

displaying, in a second display section, an identifier corresponding to the first document, and

providing an interface element configured to receive, from the user input pertaining to the first document, the input comprising information.

The Examiner asserts that a broad, yet reasonable, interpretation of appellant's claim limitation would be displaying information in a document to a user in a first display, which can be a screen. The Examiner asserts that displaying on a second display an identifier corresponding to a document can be broadly read to be displaying the identifier on another client system. Appellant has not claimed that the information and the identifier are displayed simultaneously nor has appellant claimed that the information and identifier are displayed to the same user on the same client system. Therefore, in response to appellant 's argument that the Porcari fails to show certain features of appellant 's invention, it is noted that the features upon which appellant relies (i.e., allowing ***a user*** to view both a citation document and identifiers ***in separate display sections on a display***) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is nothing in the claim limitations that indicates that the identifier is being displayed on is the same display that displays the information in the citation document. There is nothing in the claim language that requires the two displays to be presented to the same user on the same client system or that requires the displays to even be on the same systems. Moreover, the claim language is devoid of any limitation

stating that the first display section and the second display section are separate display sections ***on a display***.

The Examiner asserts Porcari discloses a hyperlink that is used so that the disclosure and connection with the server may be obtained [0033]. Porcari discloses that users are invited to review and approve documents and are provided convenient hyperlinks to specific documents [0015]. The Examiner asserts that the hyperlink is an identifier corresponding to a document. The Examiner asserts that once the user activates the hyperlink, information in a document is displayed to the user in a second display. Moreover, Porcari discloses a docketing system which records prior art references through a citation system such as a patent number. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure statement is preferably transmitted as an XML document file (the Examiner interprets this as a display section having identifiers corresponding to a reference) having hyperlinks to each reference (the Examiner interprets the activation of the hyperlink and retrieval of the reference documents as displaying citation information in a citation document to a user in another display).

1. Porcari fails to teach or suggest receiving a citation document

Appellant briefly mentions claim 16 on page 15 of the Appeal Brief. Claim 16 is directed to the limitation of "wherein the citation document is received by electronic mail". Porcari discloses electronic documents being received by email [0033] [0037].

Appellant states that neither of the passages cited by the Examiner, nor any other portions of Porcari, teach or suggest "receiving a citation document on a server system, wherein the citation document is an electronic document including citation information for one or more prior art references" as recited by claim 1. Appellant further states that, even assuming, *arguendo*, that the information disclosure statement prepared by the docketing system might be a citation document, Porcari includes no teaching that this information disclosure statement might be received anywhere, let alone on the same server that stores a plurality of references.

As to appellant's statement that, even assuming, that the information disclosure statement prepared by the docketing system might be a citation document, the Examiner directs the appellant to page 9 of the appellant's appeal brief, wherein appellant states, in response to the Examiner's question as to what appellant is identifying as a citation document, that:

Further, to the extent there is any question about the meaning of the term "citation information," the Application itself describes the concept of citation information, and claim 2 in fact clearly defines one example of citation information: "the displayed citation information includes information about one or more prior art reference documents submitted to a patent office and an indication of whether each prior art reference document was considered by the patent office."

Applicant states on page 10 of the appeal brief that:

Fig. 20 clearly shows the interplay between the citation document (2010) and the displayed identifier for several particular references (2025), along with their associated interface elements (2022, 2033); the written description explains how this interplay works: "A user may advantageously view and analyze *the form 1449* along with the document links to determine whether or not additional information needs to be entered into the IP data processing system."

For example, a user may review each cited reference *in the form 1449*, and enter information corresponding to whether or not a patent office has considered the reference by mouse clicking the input select elements (e.g., yes and no select inputs such as check boxes or check circles) for each of the document links [2025]."

Appellant states on page 4 of the appeal brief, in the summary of the claimed invention, that, as disclosed in the application, an example of a citation document is a PTO form 892 or 1449.

Thus, the Examiner does not understand how the applicant can argue that an information disclosure statement (a form 1449) is not a citation document. The Examiner asserts that Porcari discloses an information disclosure document, which, as set forth above by appellant, is a citation document.

Moreover, as to appellant's statement that Porcari does not teach that the information disclosure statement might be received anywhere, let alone on the same server that stores a plurality of references, the Examiner asserts that Porcari discloses an on-line invention disclosure system (10) that is a web-based system having a web server (12) that is coupled to a plurality of users. The web server may be coupled to a directory server (16) containing user information and to a database system (18). The database system may contain both docketing information and disclosure information (paragraph [0025]). Porcari discloses that other documents and information which are helpful in the preparation of a patent application may be attached to the disclosure as file attachments and stored in the system with the disclosure (see paragraphs [0033] and [0039]). Porcari further discloses a search function wherein the search results for

the most relevant documents are stored together with the disclosure (see paragraph [0045]). In addition, Porcari discloses that the system optionally includes a system to reference prior art documents with hyperlinks to the stored references (see paragraph [0056]). Porcari discloses that the docketing system records the prior art references through a citation system such as patent number and prepares an information disclosure statement where the citation system links to a repository on the internet that contains the reference documents. The information disclosure statement is transmitted as an XML file having hyperlinks to each reference (paragraph [0058]). The Examiner asserts, as set forth in paragraph [0025], that Porcari discloses the docketing system and disclosure information being stored in the database system (18) which is coupled to the server. Thus, the Examiner asserts that an information disclosure statement is a citation document and Porcari discloses an information disclosure statement, thus a citation document. Porcari discloses storing search results of the most relevant documents together with the disclosure on the server system. Thus, Porcari discloses a citation document with citation information for one or more prior art references being stored on a server.

Moreover, as set forth above, the Examiner asserts that the data identifying the documents as **reference** or **citation** documents, that the information is **citation** or **reference** information, that the **reference** information is **information to be disclosed to a patent office** is non-functional descriptive data and adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive

material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, this data does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

2. Porcari fails to teach or suggest displaying citation information in a first display section.

Appellant again states that, even assuming (without conceding) that the information statement disclosed by Porcari might be a citation document, Porcari still fails to teach or suggest that this information disclosure statement is ever displayed to a user.

Since appellant has not defined the term "citation document", the Examiner asserts that a citation document can be any document. It can be an information disclosure statement or it can be a reference document or any other type of document. It can be a list of relevant prior art retrieved from searches. Since appellant has not expressly stated that the citation document is an information disclosure statement, the Examiner can assume that any document which includes information about one or more prior art references can be a citation document. Therefore, by providing the results of a search to the inventor whereby various documents may be selected as being on point

and whereby a list of most relevant documents is provided (identified in Porcari as invention disclosure information) and stored together with the disclosure (see paragraph [0045]), the Examiner asserts that Porcari discloses displaying citation information to a user in a display section.

3. Porcari fails to teach the use of multiple display sections.

Appellant states that, even assuming that Porcari did somehow suggest the display of a citation document (which appellant asserts it does not for multiple reasons discussed by appellant in the appeal brief), Porcari still would fail to teach or suggest the specific display techniques recited by claim 1. Appellant states that the claim limitations of claim 1 recite "displaying the citation information in the citation document to a user of a client system, in a first display section" and "displaying, in a second display section, an identifier corresponding to the reference".

In the Remarks submitted with the amendment on November 7, 2006, the appellant states that:

Indeed, the brief teaching in Porcari that is relevant to the present claims merely suggests that a system to disclose relevant references might prepare an information disclosure statement "where the citation system links to a repository in the internet that contains the referenced document." (Porcari, ¶ 0058). In contrast, claim 1 is directed to a method in which a citation document (such as a notice of cited references, etc.) is received, and in which citation information from **that document is displayed alongside an identifier for a reference**, along with an interface element that is configured to receive input comprising information about a relationship between (at least some of) the citation information and the reference. This functionality could, for example, be used to allow a user to indicate whether a particular reference has been considered by the patent office, (see, e.g., claim 12) which beneficially can be used to ensure that all relevant references have been considered.

The applicant states on page 10 of the appeal brief that:

Hence, the inventive concept recited by claim 1 is a method that displays, for a user, both a citation document and identifiers for one or more references, and that allows a user to provide input, with respect to each of the references, that indicates whether a patent office has considered that reference, based on the citation information in the citation document. **"By providing the user with an interface where citation information from a patent office can be viewed alongside electronic reference document identifiers**, a user may efficiently input information into the system to reconcile and manage the information in an IP data processing system with the information at a patent office." Application, p. 35, 11.5-9.

The Examiner notes that, as set forth above, appellant has not claimed that the document is displayed **alongside** an identifier for a reference. Appellant's claim limitations read **displaying the citation information in the citation document to a user of a client system, in a first display section and displaying, in a second display section, an identifier corresponding to the reference**. There is nothing in the claim limitations that require the displaying of the identifier to even be displayed on the same user computer. There is nothing claiming that the two display sections are two sections of one display as appellant is now arguing. Thus, the Examiner asserts that a first display section and a second display section can be a first screen and a second screen, such as the screen providing the hyperlink (one screen providing an identifier) and another screen providing the reference after the hyperlink is activated (a second screen providing reference information). The first display section and the second display section can even be on two different client systems.

4. Porcari fails to teach or suggest the interface element recited by claim 1.

Appellant states that claim 1 recites providing an interface element associated with the identifier and that the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference. Appellant states that while paragraph [0056] of Pocari discloses the concept of hyperlinks, which appellant states may be considered interface elements, appellant states that Porcari does not teach or suggest that those hyperlinks might be configured to receive from the user input comprising information about a relationship between citation information from the citation document and the reference.

Appellant states that in response to appellant's arguments submitted with an amendment on November 7, 2006, the Examiner stated that "as for the interface element configured to receive, from the user, input, a keyboard or mouse would read on this limitation" (see Final Office Action, page 13). Appellant then states that while it is true that claim elements must be given a broad reasonable construction during prosecution, this interpretation by the Examiner is not reasonable given the disclosure in the application. Appellant states the interface elements as recited by claim 1 are elements of a graphic user interface, such as radio buttons, check boxes, and the like, not hardware devices. Appellant further states that, assuming that a mouse or keyboard might read on the recited interface element, there is no teaching or suggestion in Porcari that such a mouse or keyboard might be configured to receive input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.

First, in response to appellant's argument that Porcari fails to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., elements of a graphical user interface, such as radio buttons, check boxes, and the like) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Secondly, the appellant states on page 11 of the appeal brief that the nature and operation of the interface element (which can be a checkbox, radio button, etc) is described above. Appellant further states that the interface elements recited by claim 1 are elements of a graphical user interface, such as radio buttons, check boxes, and the like, not hardware and directs the Examiner to page 35, lines 1-8 of the specification and Figure 20.

Page 35, lines 1-8 state:

A user may simultaneously view and analyze the citation information, and then enter information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers into the server system using **input select elements**, such as select boxes, select circles, electronic buttons, or other types of commonly known input techniques. By providing the user with an interface where citation information from a patent office can be viewed alongside electronic reference document identifiers, a user may efficiently input information into the system to reconcile and manage the information in an IP data processing system with the information at a patent office.

The Examiner asserts that neither this section nor Figure 20 identify the term "interface element" as elements of a graphical user interface, such as radio buttons, check boxes, and the like, but not hardware. Furthermore, a careful search of

appellant's specification does not provide any definition as to how appellant defines "interface element".

Third, page 10 of the appellant's appeal brief states that:

Fig. 20 clearly shows the interplay between the citation document (2010) and the displayed identifier for several particular references (2025), along with their associated **interface elements** (2022, 2033); the written description explains how this interplay works: "A user may advantageously view and analyze the form 1449 along with the document links to determine whether or not additional information needs to be entered into the IP data processing system. For example, a user may review each cited reference in the form 1449, and enter information corresponding to whether or not a patent office has considered the reference **by mouse clicking the input select elements** (e.g., yes and no select inputs such as check boxes or check circles) for each of the document links [2025]."

Here, a mouse is clicked, thus, the Examiner asserts that a mouse is an interface element configured to receive, from a user, input. Moreover, this section discloses "input select elements" as yes and no select inputs such as check boxes or check circles. However, this section does not identify an "interface element".

Page 35 of appellant's specification discloses:

A user may simultaneously view and analyze the citation information, and then enter information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers into the server system using **input select elements**, such as select boxes, select circles, electronic buttons, **or other types of commonly known input techniques**. By providing the user with an interface where citation information from a patent office can be viewed alongside electronic reference document identifiers, a user may efficiently input information into the system to reconcile and manage the information in an IP data processing system with the information at a patent office.

Once again, rather than identifying the term "interface elements" as elements of a graphical user interface, such as radio buttons, check boxes, and the like, the

specification refers to input select elements such as select boxes, select circles and electronic button, which appellant refers to as commonly known input techniques.

The Examiner further notes that appellant has provided information in the arguments to make up for deficiencies in the original disclosure. While the Examiner carefully notes applicant's arguments, appellant's arguments are not part of the original disclosure. For instance, in the above stated paragraph on page 10 of the appellant's appeal brief, the Examiner makes several observations.

Fig. 20 clearly shows the interplay between the citation document (2010) and the displayed identifier for several particular references (2025), along with their associated **interface elements (2022, 2033)**; the written description explains how this interplay works: "A user may advantageously view and analyze the form 1449 along with the document links to determine whether or not additional information needs to be entered into the IP data processing system. For example, a user may review each cited reference in the form 1449, and enter information corresponding to whether or not a patent office has considered the reference **by mouse clicking the input select elements** (e.g., yes and no select inputs such as check boxes or check circles) for each of the document links [2025]."

First, it is in appellant's arguments that appellant now tries to identify the term "interface element". A careful review of the disclosure as to Figure 20 discloses the following:

Fig. 20 illustrates a method of managing information disclosure statements according to one embodiment of the present invention. Process form 1449 Web page 2000 includes a first display section 2010 for displaying an image file of a form 1449. Process page 2000 also includes a second display section 2020 for displaying links 2025 (e.g., patent numbers, document titles) to the electronic reference documents associated with the case corresponding to the form 1449. The electronic reference documents are displayed in three sub-sections 2021 for U.S. Patent Documents, 2024 for Foreign Patent Documents, and 2026 for other non-patent documents. Of course, other identifiers such as patent application serial numbers could be used. A user may advantageously view and

analyze the form 1449 along with the document links to determine whether or not additional information needs to be entered into the IP data processing system. For example, a user may review each cited reference in the form 1449, and enter information corresponding to whether or not a patent office has considered the reference by mouse clicking the input select elements (e.g., yes and no select inputs such as check boxes or check circles) for each of the document links 2050. Thus, when the yes check box is mouse clicked by the user, the information entered into the system indicates that the form 1449 indicates that the electronic reference document corresponding to the yes check box has been considered by a patent office, and when the no check box is mouse clicked by the user, the information indicates that the electronic reference document corresponding to the no check box has not been considered by the patent office. If neither yes nor no is mouse clicked, then the form 1449 indicates that the reference has not yet been considered by the patent office.

The Examiner notes that there is nothing in this section disclosing (2022) and (2033) as being "interface elements" as appellant now contends. In fact, there is no description or disclosure as to reference numbers (2022) or (2033) in the specification at all. Furthermore, Figure 20 does not provide any reference or reference numbers 2022 or 2033.

Furthermore, the Examiner notes that in the summary of the claimed invention on page 5, the appellant states that:

According to the method of claim 1, a second display section displays an identifier corresponding to the first reference. *Id.*, p. 3, ll. 13-17, p. 35, ll. 22-30, Fig. 20. The method also comprises providing ***an interface element (which is sometimes referred to in the Application as an "input select element," which can include, for example, a checkbox, electronic button, and/or the like)*** associated with the identifier; in an aspect, the interface element is configured to receive, from the user, input pertaining to the first reference. *Id.*, p. 3, ll. 15-10, p.35, ll. 1-8, Fig. 20. The input comprises information about a relationship between at least some of the citation information in the citation document and the first reference. *Id.* ***Fig. 20 illustrates, as one example of interface elements, a set of radio buttons 2022 and 2033.***

The Examiner asserts that the term "interface element" is not present in the appellant's original disclosure. Applicant consistently refers to "input select elements" in the original disclosure. Now in the appeal brief, appellant states that an "interface element" is sometimes referred to in the application as an "input select element" and that Figure 20 illustrates an example of interface elements as a set of radio buttons 2022 and 2033. Again, reference number 2022 and 2033 are not present in the specification nor are these reference number shown in Figure 20.

The Examiner asserts that the fact that the element is **associated** with the identifier means simply that the element is related to the identifier in some way or manner. However, it does not mean that the identifier is provided or displayed. The Examiner further asserts that input **pertaining** to the first reference or document can be any type of information that relates or is relevant to the first document. The fact that the input comprises information about a relationship between the information can be any type of information regarding a relationship, for example, the citation information and the first reference can be authored by the same person, or owned by the same assignee, or printed in the same publication or printed by the same publisher. The Examiner further asserts that the limitation of "providing an interface element associated with the identifier, wherein the interface element **is configured to receive**, from the user, input" is not a positive recitation of any input being actually received. Furthermore, the Examiner asserts that the fact that the input comprises information "about a relationship between at least some of the citation information in the citation document and the first reference" is non-functional descriptive data, not functionally related to the steps of the

method. The Examiner asserts that the data identifying the input information adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the input information does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

The appellant states on page 10 of the appeal brief that:

Hence, the inventive concept recited by claim 1 is a method that displays, for a user, both a citation document and identifiers for one or more references, and that allows a user to provide input, with respect to each of the references, that indicates whether a patent office has considered that reference, based on the citation information in the citation document. **"By providing the user with an interface where citation information from a patent office can be viewed alongside electronic reference document identifiers,** a user may efficiently input information into the system to reconcile and manage the information in an IP data processing system with the information at a patent office." Application, p. 35, 11.5-9.

The Examiner asserts that the computer with a keyboard and a Graphical User Interface shown in Figure 1 of Pocari is an interface element configured to receive input from a user. The Examiner further notes that appellant is arguing patentability based on features that appellant has not positively claimed. The interface, as claimed by appellant, is only configured to receive input. There is no positive recitation of input actually being received. Appellant has not defined what an "interface element" is in the

specification. Furthermore, appellant has only claimed displaying citation information in a first display and displaying, in a second display, an identifier corresponding to the reference. There is no positive recitation that would allow for citation information to be viewed alongside or simultaneously with the identifiers. As stated above by the Examiner, the Examiner asserts that as set forth in claim 1, the displays can be separate screens or can be displays on different user computers or various other methods of displaying information.

5. Claims 2-11, 14, and 16-19

Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

E. Claim 12 is patentable under 35 U.S.C. Section 103(a) over Porcari.

Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

F. Claim 15 is patentable under 35 U.S.C. Section 103(a) over Porcari and Rivette.

Claim 15 is directed to wherein the interface element is configured to allow the user to indicate an additional electronic document from an external source and the information is entered by loading an electronic document form an external source. Appellant states that the Final Office Action does not identify and a review of Rivette does not reveal, any teaching or suggestion in Rivette of the elements of claim 1 missing form the disclosure of Porcari.

Thus, the Examiner asserts, that except to the arguments submitted as to claim 1 and addressed by the Examiner above, appellant has not provided any arguments as to the limitations of claim 15. Therefore, appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(11) Related Proceeding(s) Appendix

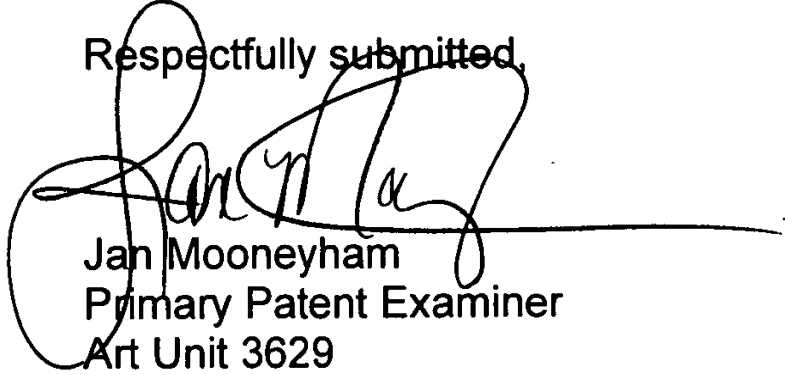
Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Jan Mooneyham
Primary Patent Examiner
Art Unit 3629

Conferees:



John Weiss, Supervisory Patent Examiner, Art Unit 3629



Dennis Ruhl, Primary Patent Examiner, Art Unit 3629